

(2014) 07 DEL CK 0196

In the Delhi High Court

Case No : I.A. No. 961/2013 in CS (OS) 110/2013

General Mills Marketing Inc

APPELLANT

Vs

South India Beverages Pvt. Ltd.

RESPONDENT

Date of Decision : 23-07-2014

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2
Trade Marks Act, 1999 — Section 142, 17, 17(2)(a)(i)

Citation : (2015) 214 DLT 123

Hon'ble Judges : Jayant Nath, J

Bench : Single Bench

Advocate : Anuradha Salhotra, Sumit Wadhwa and Tushar A. John, Advocate for the Appellant; Prathiba M. Singh, Joseph Pookkatt, Saurabh S. Sinha and Jaya Mandelia, Advocate for the Respondent

Final Decision : Disposed Off

Judgement

Jayant Nath, J.—The present application is filed under Order XXXIX Rules 1 and 2 CPC seeking ad interim injunction to restrain the defendant from using the trademark "DDAAZS" or any other deceptively similar trademark to that of the plaintiffs trademark "HAAGEN-DAZS" and "DAZS" in relation to the goods manufactured and/or marketed by them or in relation to their business or in any other manner. The accompanying plaint is filed by the plaintiff seeking the relief of permanent injunction and other connected reliefs in relation to its registered trademark "HAAGEN- DAZS" and "DAZS".

2. As per the averments in the plaint, plaintiff no.1 is a company existing under the laws of the State of Delaware, USA. The second plaintiff is an affiliate of plaintiff no. 1 and is registered in India. It is stated that the history of the plaintiffs can be traced back to 1860s. Plaintiff no. 1 claims to be one of the worlds leading food companies, operating in over 100 countries including India, marketing more than 100 consumer brands including HAAGEN-DAZS, CHEERIOS, NATURE VALLEY, PILLSBURY etc.

3. It is averred that the plaintiffs provide various products such as ice creams, frozen yogurts and other desserts under the trademark "HAAGEN- DAZS". It is averred that "HAAGEN-DAZS" was introduced in the year 1960. It is further averred that the words "HAAGEN" and "DAZS" are coined words and have no dictionary meaning. It is stated that the plaintiff no. 1 has several trademark registrations for the mark "HAAGEN-DAZS" in several countries. It is also been stated that registration for the mark "DAZS" in isolation has also been obtained in China. It is further averred that the plaintiffs under the trademark "HAAGEN-DAZS" have garnered extensive credibility in business and have witnessed tremendous sales resulting in accrual of large scale goodwill and reputation across the globe. It is averred that the net sales worldwide (excluding U.S. and Canada) for "HAAGEN-DAZS" products in the years 2010-2012 is approximately 2.483 billion USD. It is also averred that plaintiff no.1 has expended great sums of money and effort in promoting, advertising and popularizing its trademark "HAAGEN-DAZS" internationally. The advertising and consumer promotion expenditure worldwide (excluding U.S. and Canada) by the plaintiffs for the years 2010-2012 is approximately 0.279 billion USD.

4. It is averred by the plaintiffs that "HAAGEN-DAZS" products are available in India since the year 2007 and were imported through one Taurus International which is engaged in the business of import of branded food and non-food products. It is further averred that in the latter half of the year 2008 plaintiff no. 1 directly launched "HAAGEN-DAZS" products in India and the first "HAAGEN-DAZS" shop opened in New Delhi on 11.12.2009.

5. It is further averred that plaintiffs have obtained registrations for the mark "HAAGEN-DAZS" in India in respect of ice cream, ices, sherbet, sorbet and frozen confections in class 30 dated 21.01.1993 and also on 8.01.2008 in classes 29, 30 and 42. It is averred that these marks have been duly renewed, are valid and subsisting. The plaintiffs aver that as they are the proprietors of the mentioned trademark, they have exclusive right to use the trademark "DAZS" in isolation as well, as the same is the part of the registered trademark "HAAGEN-DAZS" under registration nos. 588965, 588966 and 1639044 and is subject of separate applications which are pending registration in class 29, 30 and 43. The gross sales figure for "HAAGEN-DAZS" products in India for the year 2010-2011 is Rs.11.3 crores. It is also urged by the plaintiffs that while carrying out a search on the internet for "DAZS" in isolation, it shows reference of the first plaintiff only.

6. It is urged that in or around January 2011, the plaintiffs attention was drawn to an application filed by the defendant on January 13, 2010 for registration of the trademark "DDAAZS" under number 1908477 in class 30 in respect of ice creams and frozen desserts. It is stated that the defendant in its application has claimed user of the mark since October 1, 2009. It is averred by the plaintiffs that the trade mark "DDAAZS" of the defendant is phonetically, structurally and visually similar to the plaintiffs registered trademark "HAAGEN-DAZS" and the goods for which the defendant is seeking registration are the same as the goods

for which the mark of the plaintiffs was registered. It is averred that the plaintiffs opposed the impugned mark of the defendant and the said opposition is pending with the Registrar of Trade Marks. It is further averred that a settlement proposal was sent to the defendant by the plaintiffs on October 19, 2011 asking them to amend their mark "DDAAZS" to "DDAS". The defendant sought extension of time to discuss the settlement proposal with their Directors and finally refused to accept the proposal. It is urged by the plaintiffs that the defendant is diluting the reputation and goodwill of the plaintiffs product "HAAGEN-DAZS".

7. The defendant has filed its written statement. It is urged by the defendant that the plaintiffs have no cause of action to file the instant suit, as an identical controversy is already pending adjudication in the Court of Additional City Civil Judge at Bangalore. It is submitted that the averment of the plaintiff that being proprietor of the trademark "HAAGEN-DAZS" it has exclusive right to the use of "DAZS" as it is part of the registered trademark is contrary to Section 17 of the Trade Marks Act, 1999, which clearly states that registration of a trade mark shall confer on the proprietor exclusive right to the use of the trademark taken as a whole. The defendant further urges that this fact is substantiated by the averment of the plaintiff that it has applied for the registration of the mark "DAZS" in isolation, applications for which are pending consideration.

8. It is urged by the defendant that it commenced manufacturing and selling ice-creams and frozen desserts in 2009. It is averred that the defendant adopted its mark "DDAAZS" with an entirely honest and bonafide intention which is corroborated by the fact that the essential elements of the trademark are derived from the name of the father of one of the founder Directors being Late Shri Dwaraka Das. It is stated that the letter "D" in the trademark "DDAAZS" stands for Dwaraka and "DAAZS" represents the second part of the name "Das" in a stylized manner. It is further stated by the defendant that it has been using its trademark "DDAAZS" continuously and extensively since the year 2009, in the states of Karnataka, Tamil Nadu and Andhra Pradesh and has established sales channels in all the four southern states of the country. It sells the ice cream under its trademark through sale outlets numbering more than a thousand set up in various states. It is further averred by the defendant that they have gained recognition and earned goodwill and reputation in the market under their mark "DDAAZS" and that they have sales amounting to crores of rupees. It is urged by the defendant that the mark of the defendant "DDAAZS" and that of the plaintiff "HAAGEN-DAZS" don't have any phonetic, structural or visual similarity.

9. It is further contended by the defendant that the class of persons that would be customers of the plaintiff can never mistake another product as that of genuine "HAAGEN-DAZS" product. It is said that difference in the market price of the two products is enormous and there can be no scope for any confusion. The unit sale price of the defendants product ranges between Rs. 5 and Rs. 30. The unit sale price of the plaintiffs product is Rs. 180 per scoop to Rs. 550/- per sundae. The labels, packaging cartons are all too separate and distinct to leave

any scope for confusion. The product of the plaintiff being of premium character, would not be available in small shops that sell the defendants product. It is further urged that the defendant has 1,050 outlets as opposed to the handful of outlets that the plaintiff can claim which too are situated in niche/premium stores in large cities. The plaintiff it is urged has no presence in semi-urban or un-urban areas in India.

10. The defendant states that in this background defendant applied for the registration of the trademark "DDAAZS" with the Trade Mark Registry on 13.01.2010 vide Application no. 1908477 in class 30 in relation to goods viz., ice cream and frozen desserts.

11. I have heard learned counsel for the parties extensively on hearings spread over several dates. Parties have filed their short submissions.

12. Learned counsel appearing for the plaintiffs has apart from reiterating the submissions made in the plaint strenuously urged that "DAZS" is an essential feature of the plaintiffs trade mark. It is also pointed out that the application for registration for "DAZS" separately has also been filed on 22.10.2012. Hence, it is urged that as the defendant is copying the essential features of the trade mark of the plaintiff, it is liable to be restrained as prayed for in the injunction application.

13. Learned counsel appearing for the plaintiff has relied upon judgment of a Division Bench of this High Court in the case of Kirorimal Kashiram Marketing and Agencies Pvt. Ltd. Vs. Shree Sita Chawal Udyog Mill, to contend that copying of a prominent part of the trademark leads to deceptive similarity specially when the products of both the parties are the same. Reference is also made to Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, to contend that where essential features of a trademark of the plaintiff have been adopted by the defendant, the fact that the get up, packing etc. of the goods or box of the defendant show a marked difference or indicate a different trade origin from that of the registered proprietor of the mark would be immaterial.

14. Learned counsel appearing for the defendant has apart from reiterating the contents of the written statement urged that the two marks in question are neither similar nor identical. She has urged that there is no chance of any deception. It has been denied that the essential feature of the plaintiffs trade mark is "DAZS". It is urged that the essential feature of the trade mark is "HAAGEN". It is further urged that there is no scope for confusion. The price of the Ice Cream of the defendant for 90ml is around Rs.5/- whereas for a 100ml cup, the plaintiffs charge Rs.200/-. It is further urged that given these facts there was no need for the defendant to piggy back on the Ice Cream of the plaintiffs. The Ice Cream of the defendant is for the masses while the Ice Cream of the plaintiffs is for the elite only. It is urged that the defendant is an honest and at best a concurrent user. The use of the brand name "DDAAZS" is bona fide. It is further urged that the plaintiffs opened their first shop in India only in 2009. The defendant has also started using its trade mark in 2009 before the opening

of the first shop by the plaintiffs in India. It has been strenuously urged that earlier the goods of the plaintiffs were only imported by Taurus International which imports all kinds of brands. In fact, it is urged that there is only one stray invoice placed on record by the plaintiffs to show user prior to 2009. Further there is no advertisement of its brand by the plaintiffs before 2010. It is stressed that in fact the application of the plaintiffs for registration of the mark "DAZS" was objected to by the Trade Mark Registry. It is also strenuously urged that there is delay and laches on the part of the plaintiffs to approach this Court. The plaintiffs have allowed the defendant to grow and cannot now approach this Court seeking interim injunction. It is pointed out that the defendant adopted the trade mark in 2009. An application for registration of the trade mark was made in 2010. The plaintiffs have filed an opposition in 2011. The defendant also filed a suit in the civil court in Bangalore in 2012. The plaintiff has now after lapse of considerable time filed the present suit. Hence it is urged that there are no bases to grant any interim orders to the plaintiffs. In case any interim orders are passed, the defendant will face a lot of hardship as it will have to change its brand name. This hardship would be for no fault of the defendant.

15. Learned counsel for the defendant has relied upon various judgments some of which may not be relevant for the present purpose to support her submissions. Some of the judgments have been referred to in the course of dealing with the submissions of the parties.

16. Learned counsel for the plaintiffs has in rejoinder urged that there is no delay and laches on the part of the plaintiffs. It is further pointed out that the registration of the mark "HAAGEN-DAZS" of the plaintiffs is of 1993. It is stated that the application of the defendant for registration of its trade mark was advertised on 25.10.2010. The plaintiffs have filed notice of opposition on 08.02.2011. On 19.10.2011 the plaintiffs have written to the defendant to sort out the issue. A reference is made to various correspondences between the parties to state that the defendant was only trying to gain time and while correspondence was on to settle the matter, the defendant has filed the suit in the City Civil Court, Bangalore. Hence, it is urged that there has been no delay on the part of the plaintiffs. Reference is also made to the judgment in the case of Alfred Dunhill Limited Vs. Kartar Singh Makkar and Others, where this Court in a case where the plaintiff had approached after lapse of 11 years held that in case of passing off/infringement or trademark delay by itself cannot come in the way of granting injunction. In the facts of that case also the delay was explained on the basis that the plaintiff company had a belief that the matter could be resolved. It is further urged that Section 17 is not applicable to the facts of the present case. As apart from the fact that the defendant is copying the essential feature of the trade mark of the plaintiffs, the plaintiffs have moved a separate application for "DAZS" for registration.

17. For the purpose of disposing of the present application, the basic controversy would be as to whether the plaintiff has successfully shown prima facie

infringement of its trademark "HAAGEN-DAZS" on account of the use of the trademark "DDAAZS" by the defendant. One of the issues would be as to whether "DAZS" as used by the plaintiff in its registered trademark "HAAGEN-DAZS" is an essential feature of the trademark of the plaintiff. Learned counsel for the plaintiff has strenuously urged that "DAZS" is an essential feature of the trademark of the plaintiff and that the trade mark used by the defendant is phonetically, structurally and visually similar to the trade mark of the plaintiff. The learned counsel for the defendant has argued that the essential feature of the trademark of the plaintiff is "HAAGEN". She has denied that the trade mark of the defendant has any similarity to the trade mark of the plaintiff.

18. Reference may be had to the judgment cited by learned counsel for the plaintiff in the case of Kirorimal Kashiram Marketing & Agencies Pvt. Ltd. (supra). In that case the registered trademark of the plaintiff was "Double" Deer whereas the defendant was using the trademark "Golden Deer." The Division Bench held as follows:

5. In our opinion, the learned Single Judge has fallen into an error in declining the grant of interim injunction to the appellant. The overriding aspect in a case such as the present is that deer is a prominent part of the trademark of the appellant. Copying of a prominent part of a trademark leads to deceptive similarity especially when the product of both the parties is the same. The expression "Deer" was arbitrarily adopted by the appellant with respect to its product being rice. A deer has no connection or co-relation with the product namely rice. Such arbitrary adoption of a word mark with respect to a product with which it has no co-relation, is entitled to a very high degree of protection, more so, as the appellant's trademark is a registered trademark. The use by the respondent of its trademark is admittedly subsequent to that of the appellant. The first registration of the appellant is of the year 1985 and then of 1990. The respondent claims the first user only from the year 1999, and, as the later discussion will show, that is also not a correct fact because the user of the respondent is prima facie only from around the year 2003.

6. That copying of a prominent part of a trademark of a person is prohibited, more so, when the same is a registered trademark, is clear from the following observations of a judgment of a Division Bench of this Court in the case reported as Goenka Institute of Education and Research Vs. Anjani Kumar Goenka and Another,

19. Similarly, reference may also be had to the Kaviraj Pandit Durga Dutt Sharma (supra) cited by learned counsel for the plaintiff of which relevant portion of paragraph 28 reads as follows:

28.In an action for infringement, the plaintiff must, no doubt, make out that use of the defendant's mark is likely to deceive, but were the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no

further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the make would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

20. It would also be useful to refer the judgment of this Court in the case of Pernod Ricard, SA and Another Vs. Real House Distillery Pvt. Ltd. and Another, where in paragraphs 51 to 54 this Court held as under:

51. In the judgment of the Supreme Court in Ruston and Hornby Ltd. v. Zamindara Engineering Co., the Supreme Court held that an infringement of a registered trade mark takes place not merely by exact imitation but by the use of a mark so nearly resembling the registered mark as to be likely to deceive.

52. In the case of Taw Manufacturing Coy. Ltd. v. Notek Engineering Coy. Ltd. and Anr., (1951) 68 Reports of Patent Cases 271(2) the question for decision was whether there was infringement by the latter device of the former registered trade mark and the Court held as under :

A trademark is infringed if a person other than the registered proprietor or authorised user uses, in relation to goods covered by the registration, one or more of the trademarks essential particulars. The identification of an essential feature depends partly upon the Courts own judgment and partly upon the burden of the evidence that is placed before the Court.

53. As observed by the Privy Council in De Cordova and others Vs. Vick Chemical Company, 68 R.P.C. 103, 106 it was held as under :

It has long been accepted that, if a word forming part of a mark has come in trade to be used to identify the goods of the owner of the mark, it is an infringement of the mark itself to use that word as the mark on part of the mark of another trader, for confusion is likely to result.

54. In Atlas Cycle Industries Ltd. Vs. Hind Cycles Limited, this Court held :

In an action for an alleged infringement of a registered trade mark, it has first to be seen whether the impugned mark of the defendant is identical with the registered mark of the plaintiff. If the mark is found to be identical, no further question arises, and it has to be held that there was infringement. If the mark of the defendant is not identical, it has to be seen whether the mark of the defendant is deceptively similar in the sense it is likely to deceive or cause confusion in relation to goods in respect of which the plaintiff got his mark registered. For that purpose, the two marks have to be compared, "not by placing them side by side. but by asking itself whether having due regard to

relevant surrounding circumstances, the defendant's mark as used is similar to the plaintiff's mark as it would be remembered by persons possessed of an average memory with its usual imperfections", and it has then to be determined whether the defendant's mark is likely to deceive or cause confusion.

21. It may be noted that the above judgment was modified by the Division Bench of this Court in Real House Distillery Pvt. Ltd. and Another Vs. Pernod Ricard S.A. and Another, in connection with the new label which was sought to be used by the defendant therein after the interim injunction passed by the Single Judge. The defendant did not even challenge the above judgment of the learned Single Judge pertaining to the original label on the basis of which suit for injunction was filed.

22. Coming to the contentious issue, namely, whether the mark of the defendant is an infringement of the plaintiffs registered trademark, in my view, the word "DAZS" is an essential feature of the plaintiffs trademark and by copying one of the essential features of the trademark of the plaintiff the defendant has prima facie infringed the registered trademark of the plaintiff. The trademark used by the defendant "D-DAAZS" is phonetically and structurally similar to the Trade Mark of the plaintiff. The trademark as used by the defendant is prima facie deceptively similar in the sense that it is likely to deceive or cause confusion in relation to goods in respect of which the plaintiff has got its mark registered. A person possessing average memory is bound to get confused by seeing the trademark of the defendant. It cannot be ignored that "DAZS" is a coined word. Further both the parties are dealing with Ice-Creams.

23. The judgment of the Division Bench of this court in the case of Kirorimal Kashiram Marketing & Agencies Pvt. Ltd. vs. Shree Sita Chawal Udyog Mill Tolly Vill (supra) would clearly apply to the facts of this case.

24. I will now come to the contentions raised by the defendant. Learned counsel for the defendant has firstly strenuously urged that the claim of the plaintiff for having an exclusive right to use the mark "DAZS" on its own when the registered trademark of the plaintiff is "HAAGEN-DAZS" is contrary to Section 17 of the Trademarks Act. It is further urged that merely to overcome the hurdle of section 17 of the Act, the plaintiff has now on 29.10.2012 made a separate application for registration of the word "DAAZS" and has filed the present suit immediately thereafter only to try and bring the suit within the exception carved out u/s 17(2)(a)(i).

25. There is no merit in the said submission of learned counsel for the defendant. In fact learned counsel has herself conceded that as per the judgments of this High Court where an essential feature of the trademark is copied which feature may only constitute a part of the registered trademark, the same would tantamount to infringement of the registered trademark and this action would not be hit by Section 17 of the Trademarks Act. In the above context reference may be had to the judgments of this High Court in the case of Jagan Nath Prem

Nath Vs. Bhartiya Dhoop Karyalaya, ; United Biotech Pvt. Ltd. Vs. Orchid Chemicals and Pharmaceuticals Ltd and Others, ; Keshav Kumar Aggarwal Vs. M/s. NIIT Ltd., and Ireo Pvt. Ltd. Vs. Genesis Infratech Pvt. Ltd., ..

26. The second argument strenuously raised by learned counsel for the defendant is that the present application filed by the plaintiff is also liable to be dismissed on account of delay and laches on the part of the plaintiff. It is urged that the plaintiffs have allowed defendants to grow and cannot now approach this Court seeking interim injunction. It is explained that the defendant has adopted its trademark in 2009 and an application for registration of the trademark was made in 2010 whereas the plaintiff has filed opposition to the same in January 2011 yet the plaintiff has approached this Court in January 2013. It is urged that in the meantime the defendant has created an extensive sales network all over south India specially Karnataka and that at this stage if the injunction is passed against the defendant, it would cause a grave hardship to the defendant.

27. In my view there is no merit in the said submission of learned counsel for the defendant. Firstly, there are no pleadings raised by the defendant in this regard either in the written statement or in the reply to the present application. This argument has been raised for the first time in the course of arguments. It is not permissible for the defendant to raise these pleas now in this manner. Apart from that, defendant has not been able to substantiate the growth which allegedly took place after February 2011. Admittedly, the plaintiff has come to know about the use of the trademark by the defendant sometimes in end of 2010 or at least by February 2011 when it filed an opposition to the application of the defendant. The suit has been filed in January 2013 which constitutes an alleged delay of 2 years. What is the growth of the defendant in this period is not stated. Hence, the said plea of the defendant cannot be accepted.

28. Even otherwise in my view the plaintiff has explained the reasons for the said delay inasmuch as the parties are said to have been in correspondence in the matter to try and sort out the issues. The defendant applied for the registration of its trade mark "DDAAZS" on 13.01.2010 and the application was published on 25.10.2010 and was made available to the public on 10.11.2010. The plaintiff has filed opposition on 08.02.2011. Hence, admittedly the plaintiff was aware about the use by the defendant of the trade mark "DAZS" by the end of 2010/ beginning of 2011. Thereafter some correspondence has been exchanged between the parties. On 19.10.2011 the plaintiff sent a legal notice to the defendant to try and sort out the matter. The defendant has written on 31.10.2011. Correspondence has been exchanged by the parties on 18.11.2011, 19.11.2011, 21.11.2011 and 30.12.2011. Thereafter the defendant has filed a suit in January 2012 u/s 142 of the Trade Mark Act in the court in Karnataka. On 22.10.2012 the plaintiff has filed an application for the registration of the mark "DAZS". In January 2013 the present suit is filed. Hence the alleged delay in approaching this Court has been explained.

29. The legal position regarding delay in filing of a suit for infringement of the

trade mark is that normally delay per se does not defeat or delay the right of the plaintiff to seek injunction in a case. Reference may be had to the case of Swaran Singh Vs. Usha Industries (India) and Another, where the court has held as under:

(7) There is then the question of delay. Learned counsel for the respondents had urged that the delay is fatal to the grant of an injunction. We are not so satisfied. A delay in the matter of seeking an injunction may be a ground for refusing an injunction in certain circumstances. In the present case, we are dealing with a statutory right based on the provisions of the Trade and Merchandise Marks Act, 1958. An exclusive right is granted by the registration to the holder of a registered trade mark. We do not think statutory rights can be lost by delay. The effect of a registered mark is so clearly defined in the statute as to be not capable of being misunderstood. Even if there is some delay, the exclusive right cannot be lost. The registered mark cannot be reduced to a nullity. The principles governing other types of injunctions are not to be readily applied to a case like the present.

30. Reference may also be had to the judgment of this Court in the case of Hindustan Pencils (P) Ltd. Vs. India Stationery Products Co. and Another, , wherein in para 31 the Court held as follows:

31. Even though there may be some doubt as to whether laches or acquiescence can deny the relief of a permanent injunction, judicial opinion has been consistent in holding that if the defendant acts fraudulently with the knowledge that he is violating the plaintiff's rights then in that case, even if there is an inordinate delay on the part of the plaintiff in taking action against the defendant, the relief of injunction is not denied. The defense of laches or inordinate delay is a defense in equity. In equity both the parties must come to the Court with clean hands. An equitable defense can be put up by a party who has acted fairly and honestly. A person who is guilty of violating the law or infringing or usurping somebody else's right cannot claim the continued misuse of the usurped right....

31. Reference may also be had to the judgment relied upon by learned counsel for the plaintiff in the case of Alfred Dunhill Limited vs. Kartar Singh Makkar (supra). In that case the plaintiff had approached the Court after a lapse of 11 years where in paragraph 15 this Court held as under:

15. In Hindustan Pencils (P) Ltd. Vs. India Stationery Products Co. and Another, , it was held that in the case of passing off action or infringement of trade mark, delay by itself cannot come in the way of granting injunction. That apart, it is also significant to mention that the order dated 10.2.1995 passed by the Assistant Registrar of Trade Marks Mumbai clearly shows that on 21.9.1982, plaintiff company filed an application No.395483 in Class 24 to register the trade mark DUNHILL in respect of textile articles. In 1990, defendant No.1 company filed application to the said application and the Assistant Registrar passed the

order on 10.2.1995. This suit has been instituted in 1997. It appears that the plaintiff company refrained from instituting common law action presumably with the belief that the matter would be resolved in the aforesaid proceedings. Thus, plaintiff co. had acted reasonably and had not slept on its rights. The defendant company acted on its own peril by continuing to use the mark "DUNHILL". The delay of 11 years was excusable because plaintiff was engaged in the legal proceedings on the same subject against defendants.

32. The connected contention of the learned counsel for the defendant is that it has acted with honest and bona fide intention and that the essential elements of the trade mark used by the defendant are actually derived from the name of the father of one of the founder directors Late Sh. Dwarka Das. The letter "D" in the trade mark "DDAAZS" is said to stand for Dwarka and DAAZS is said to represent the second part of the name Das. It is urged in the course of the arguments that the word DAS could not be used by the defendant as K.C. Das is a famous brand name for Rasgullas and they would have been in violation of their trade mark. It has been further urged that there was no need for the defendant to piggy back on the Ice Cream of the plaintiff. At best the defendant is an honest and concurrent user.

33. The aforementioned submissions of the defendant are clearly without any merits whatsoever. The brand of the plaintiff is a worldwide recognized brand. It was registered in India in 1993 though as per the plaint the said brand has been in existence worldwide since 1960. The worldwide sales excluding US and Canada for the year 2010-2012 are said to be 2.48 billion US Dollars. The defendant who claims to be in the business of Ice Cream since 2009 cannot claim to be so innocent as to be unaware about the leading Ice Cream brands. Further defendant chose to take extra precautions to not violate the brand of K.C.Das Rasgullas. There is no reason why the same case could not be taken in relation to the plaintiffs brand. The contention of the defendant prima facie cannot be accepted.

34. The reliance of the learned counsel for the defendant on various judgments relating to delay, laches and acquiescence being a ground to defeat interim injunction are misplaced. The conclusions in the judgments are based on the facts of each individual case. The learned counsel has for the said purpose relied upon Rhizome Distilleries P. Ltd. and Others Vs. Pernod Ricard S.A. France and Others, , Khoday Distilleries Limited (Now known as Khoday India Limited) Vs. The Scotch Whisky Association and Others, and Power Control Appliances and Others Vs. Sumeet Machines Pvt. Ltd., .

35. In the case of Khoday Distilleries vs. Scotch Whisky Association (supra) the plaintiff had started using the offending mark in 1968. The trade mark application was filed by the defendant for registration of trade mark which was accepted. The plaintiff came to know about the appellants mark on 20.09.1974. They filed an application for rectification on 21.04.1986. In these circumstances, noticing the whole gamut of facts the court noted that the action of the plaintiff

is barred under the principles of acquiescence and/or waiver in the peculiar facts and circumstance of that case. The court noted that the principles of acquiescence would apply where the party is sitting by or is allowing another to invade its rights and spending money and it is a course of conduct inconsistent with the claim for exclusive rights of trade mark.

36. The facts of the other judgments are not discussed inasmuch as the same would be an exercise in repetition.

37. In the present facts, the plaintiff cannot prima facie be said to be guilty of acquiescence. The nature of correspondence exchanged by the parties in the relevant period does not show acquiescence by the plaintiff. Notice of opposition was filed before the Trade Mark Registry on 08.02.2011. There is no merit in the contention of the defendant regarding alleged delay or laches or acquiescence.

38. Learned counsel appearing for the defendant has further stressed that there can be no scope for confusion inasmuch as the customers of the plaintiff can never mistake another product as that of genuine "HAAGEN- DAZS" products. It is urged that the difference in the price of the defendants product ranges from Rs. 5 to Rs. 30/- whereas the price of the plaintiffs products ranges from Rs. 180/- per scoop to Rs. 550/- per Sundae. It is also urged that the label, packaging, cartons are distinct and separate and leave no scope for confusion.

39. Learned counsel for the plaintiff has rightly argued that these facts would normally have no application in a case pertaining to infringement of trade mark. These facts would normally be relevant in a case of passing off.

40. As noted above, the Supreme Court in the case of Kaviraj Pandit Durga Dutt Sharma vs. Navaratna Pharmaceutical Laboratories (supra) has held that if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get up, packing and other writings or marks on the goods of the defendant are markedly different or clearly indicate a trade origin different from that of the proprietor of the mark would be immaterial. This Court in the case of Ireo Pvt. Ltd. Vs. Genesis Infratech Pvt. Ltd. (supra) on a similar argument held as follows:

35. The third argument strenuously raised by the defendant was that the cost of the property being sold by the plaintiff is much higher than the cost of property being advertised by the defendant and there is likelihood of the same being confused. In my opinion there is no merit in the said submission. The defendant has slavishly copied the mark of the plaintiff and cannot be permitted to continue to use the said deceptively similar trade mark.

36. Reference in this context may be had to the judgement of this High Court in the case of Aman Resorts Limited Vs. Mr. Deepak Narula and Another, . This Court in that case turned down a similar argument regarding cost of the product of the plaintiff. The Court in paragraph 18 noted as follows:

18. The above discussion is however, not dispositive of the application. The

plaintiff's claim for injunction also embraces a restraint order, to enjoin the Defendant from using the AMAN mark in respect of the hotel and hospitality business. The Defendant does not here deny that the plaintiff's marks are registered. However, the contention is that its hotel, has a lower tariff, and its location and appearance is such as to leave no one in doubt that it has no association with the plaintiff. The Court has to determine the likelihood of confusion and deceptive similarity in order to arrive at a prima facie finding of infringement keeping in mind the following considerations: the broad and essential features of the competing marks will have to be viewed, the marks will have to be considered as a whole in their respective contexts, the similarities rather than dissimilarities will have to be taken note of and that the marks must be judged from the point of view of unwary purchaser of average intelligence and imperfect recollection.

This Court granted injunction in that case to the plaintiff.

37. In view of the above, there is no merit in the contention of learned Counsel for the defendant."

41. In my view accordingly there are prima facie no merits in the contentions raised by the defendant and the same have to be rejected.

42. The plaintiff has made out a strong prima facie case in their favour. The balance of convenience is also in favour of the plaintiff and against the defendant. Irreparable injury is also likely to be caused to the plaintiff. Accordingly the defendant, its agents etc. are restrained by way of interim injunction from using the trade mark "DDAAZS" or any other mark deceptively similar to that of the plaintiffs trade mark "HAAGEN-DAZS" in relation to goods manufactured or marketed by the defendant till the pendency of the accompanying suit. The present stay order will be applicable with effect from two months from today to permit the defendant adequate time to take steps to carry out necessary changes in its business as directed herein.

43. The application stands disposed of.

44. No order as to costs.

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List before the Joint Registrar on 4th September, 2014.